



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/560,746

12/15/2005

Avigdor Bieber

P-5981-US

1690

49443 7590 07/31/2009
Pearl Cohen Zedek Latzer, LLP
1500 Broadway
12th Floor
New York, NY 10036

EXAMINER

ZIMMERMAN, JOSHUA D

ART UNIT

PAPER NUMBER

2854

MAIL DATE

DELIVERY MODE

07/31/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/560,746	Applicant(s) BIEBER ET AL.	
	Examiner JOSHUA D. ZIMMERMAN	Art Unit 2854	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 May 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 22-50 is/are pending in the application.
- 4a) Of the above claim(s) 22-30 and 39-50 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 31-38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 December 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>05/29/08;12/15/05</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of Group I, Species a, and Species x in the reply filed on 05/14/09 is acknowledged.
2. Claims 22-30 and 39-50 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected Invention or Species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 05/14/09.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 31-33, 37 and 38 are rejected under 35 U.S.C. 102(b) as being anticipated by Zhao et al. (US6120965).

Regarding claim 31, Zhao et al. teach "a method of fabricating an imaged lithographic printing member, the method comprising:

imaging a selected image (column 4, line 42) onto an image-transfer film (item 16) by applying an imaging-carrying material on selected areas of said image-transfer film (column 4, lines 51-61);

applying a fluid formulation onto a substrate (30) and/or the imaged image-transfer film (column 4, lines 62-67);

laminating the imaged image-transfer film with the substrate such that the fluid formulation is captured in between and the imaging-carrying material is dipped into the fluid formulation (column 5, lines 20-35); and

curing the fluid formulation to form a solid imaging layer (column 5, lines 12-15), said solid imaging layer comprising said imaging-carrying material such that a surface of said imaging layer comprises a mirror image of said selected image (inherently, one of the two surfaces of the imaging layer will have a mirror image of said selected image)."

Regarding claim 32, Zhao et al. further teach "releasing the image-transfer film from said imaging layer (column 5, lines 29-35) such that said mirror image of said selected image is exposed (this limitation is inherently met since the image is transferred to the substrate, revealing the mirror image)."

Regarding claim 33, Zhao et al. further teach "wherein the mirror image of said selected image and the remaining area of said surface have different affinities for ink and/or ink-repellent fluid (column 4, lines 56-58; column 5, lines 1-3)." Since the image is composed of pigment particles and the overlayer, which constitutes the remaining area, is composed of a different material, the two areas will inherently have different affinities. Furthermore, since the claimed structures are substantially identical, any claimed properties are presumed to be inherent. See MPEP 2112.01.

Regarding claim 37, Zhao et al. further teach "wherein the image-transfer film is used as a protective film and is released prior to printing (column 5, lines 29-35)."

Regarding claim 38, Zhao et al. further teach "wherein the imaging comprises printing said selected image onto the image transfer film using a laser printer (column 4,

Art Unit: 2854

lines 40-45).”

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 34-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zhao et al.

Regarding claims 34-36, Zhao et al. teach all that is claimed, as in claim 31 above, including that the curing is accomplished via photochemically curing (column 5, line 13), but fail to specifically mention that the curing is accomplished “with UV radiation.” However, Examiner takes Official Notice that it was known at the time of the invention to cure adhesives or pigment images using UV radiation. Therefore, at the time of the invention, it would have been obvious to one having ordinary skill in the art to use UV radiation in the photochemical curing step of Zhao et al.

Regarding claim 35, Zhao et al. further teach that the energy is radiated “onto the image-transfer film (see the arrow radiating from item 26 in figure 1).”

Regarding claim 36, Zhao et al. teach all that is claimed, as in claims 31 and 34 above, but fail to teach that “the curing comprises radiating UV energy onto the substrate.” However, Examiner takes Official Notice that, at the time of the invention, it was known to post-expose an imaged member with UV radiation in order to complete the cure of the image and/or to increase the durability of the image. Therefore, at the

Art Unit: 2854

time of the invention, it would have been obvious to one having ordinary skill in the art to post-expose the image on the substrate with UV radiation to complete the cure of the image and/or to increase the durability of the image.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JOSHUA D. ZIMMERMAN whose telephone number is (571)272-2749. The examiner can normally be reached on M-R 8:30A - 6:00P, Alternate Fridays 8:30A-5:00P.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Judy Nguyen can be reached on 571-272-2258. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Joshua D Zimmerman

Application/Control Number: 10/560,746
Art Unit: 2854

Page 6

Examiner
Art Unit 2854

/Joshua D Zimmerman/
Examiner, Art Unit 2854